

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s):	Liang, et al.	Docket:	132489
Serial No.:	09/833,085	Art Unit:	3627
Filed:	April 11, 2001	Examiner:	Andrew J. Rudy
Title:	Facilitating Integration of Communications Network Equipment Inventory Management		

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

Dear Commissioner:

It is respectfully requested that a review be made of the final rejection prior to filing of the Appeal Brief. This request is being filed simultaneously with a Notice of Appeal. No amendments are filed with this request. Applicant believes that there are clear errors in the final rejection mailed January 26, 2007 (Final Office Action); and thus, the final rejection has omissions of one or more essential elements needed for a prima facie rejection for the reasons stated below.

I. Rejection of Claims 1-20 under 35 U.S.C. 103(a) over Applicant's disclosure

The Office Action rejected claims 1 through 20 under 35 U.S.C. 103(a) as being unpatentable over Applicant's disclosure at page 1, lines 18 through 25, stating that it "encompasses in broad scope and content Applicant's claim language". First, at page 1, line 18, the word "conventional" does not mean prior art and no prior art was admitted. Further, the description at page 1, lines 18 through 23, of the "conventional network management system" teaches away from the present invention. The conventional network management system is described as "two separate physical equipment inventory management applications with one used for providing managing online network equipment and the second used for managing offline network equipment." In contrast to this description of two separate management applications, both independent claims 1 and 20, describe that online and offline sub-object asset items are linked by an asset manager. For example, independent claim 1 states, "creating an

informational link between an online subject of the asset item and an offline subject of the asset item, wherein said system readable identification enables the asset manager to create the information link between the online subobject of the asset item and the offline subobject of the asset item.” Independent claim 20 states, “performing an informational binding operation for associating information retrievable from an online persistent asset database with corresponding information retrievable from an offline asset inventory database . . .”. Thus, the “conventional network management system having two separate management applications” described at page 1, lines 18 through 23 teaches away from the present invention.

Furthermore, the motivation or suggestion to link or integrate the functionality of the described two conventional separate equipment inventory management applications is only taught or suggested by the present application at page 1, lines 23 through 29. As stated in the specification at page 1, lines 23 through 25, “Without the functionality of these two physical equipment inventory management applications being integrated, the ability to effectively optimize the planning and utility of network equipment is limited.” No other citation for a motivation is provided in the Final Office Action. “The court must be ever alert not to read obviousness into an invention on the basis of the applicant's own statements; that is, we must view the prior art without reading into that art appellant's teachings.” *Application of Nomiya*, 184 U.S.P.Q. 607, 612 (Cust. & Pat.App. 1975). Only the present specification teaches this motivation or suggestion to link or integrate the functionality of the two separate equipment inventory management applications for online and offline network equipment. The Final Office Action has provided no other citations, except for applicant’s own statements, for such a suggestion or motivation. For these reasons, the Applicant’s disclosure fails to teach or suggest the requirements of the claims.

II. Rejection of Claims 1 through 20 under 35 U.S.C. 102 (b) by U.S. 5,959,275

In paragraph 4, the Final Office Action rejected claims 1 through 20 under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,959,275 to Hughes et al. (the Hughes reference). Though five other office actions were issued in this case prior to this Final Office Action, the Hughes reference was never cited until now in this Final Office Action.

Furthermore, the entire 102(b) rejection of all claims 1-20 is stated in two sentences in the Final Office Action:

“Hughes discloses an asset management system comprising scanning a serial or part number, e.g. 212, MPN, into the hand held client, a radio link, an online sub-object, e.g. display screen, an offline sub-object, e.g. equipment database, bay rack, shelf and slot. It is noted the repair status of the asset is inherent with equipment databases, while the database may be viewed as both a statistical and inventory report.”

Under M.P.E.P. § 2131, a claim is anticipated only if each and every element as set forth in the claim is found. The identical invention must be shown in as complete detail as contained in the claim. Furthermore, the rejection fails to concisely and definitely explain where each and every element of claims 1 through 20 are found in the Hughes reference. Thus, the Final Office Action has failed to make a prima facie case of anticipation by the Hughes reference.

Notwithstanding the failure of the Final Office Action to make a prima facie case of anticipation under 102(b), the Hughes reference fails to anticipate claims 1 through 20. For Independent Claim 1, the Hughes reference fails to disclose, *inter alia*, “creating an informational link between an online subobject of the asset item and an offline subobject of the asset item, wherein said system readable identification enables the asset manager to create the information link between the online sub-object of the asset item and the off-line subobject of the asset item.” As shown in Figure 2 of the Hughes reference and described in Column 2, lines 57 through 67, the Hughes reference only describes a “field registration process” wherein installed network assets mounted in equipment bays in the field are determined or scanned. There is no description of an offline database or creating an informational link between an online subobject of the asset item and an offline subobject of the asset item, as required by Independent Claim 1. Similarly for the same reasons, the Hughes reference fails to disclose the requirement, *inter alia*, in independent Claim 20, of “performing an informational binding operation for associating information retrievable from an online persistent asset database with corresponding information retrievable from an offline asset inventory database . . .”. Thus, the Final Office Action has

failed to make a prima facie case of anticipation by the Hughes references of claims 1 through 20.

III. Rejection of Claim 1 under U.S. Patent No. 7,058,154

In paragraph 5, the Final Office Action rejected claim 1 as being anticipated by U.S. Patent No. 7,058,154 to Stark et al. (the Stark reference). Though five other office actions were issued in this case prior to this Final Office Action, the Stark reference was never cited until now in this Final Office Action. Furthermore, the entire 102(b) rejection of claim 1 is stated in one sentence in the Final Office Action:

“Stark discloses an asset management system comprising an interactive database, e.g. 20, an on-line sub-object, e.g. computer display screen generating contingency outage schedule, an off-line sub-object, e.g. components.”

Under M.P.E.P. § 2131, a claim is anticipated only if each and every element as set forth in the claim is found. The identical invention must be shown in as complete detail as contained in the claim. Furthermore, the rejection fails to concisely and definitely explain where each and every element of claim 1 is found in the Stark reference. Thus, the Final Office Action has failed to make a prima facie case of anticipation by the Stark reference.

Notwithstanding the failure of the Final Office Action to make a prima facie case of anticipation under 102(b), the Stark reference fails to anticipate Claim 1. The Stark reference fails to disclose, *inter alia*, the requirement of “creating an informational link between an online subobject of the asset item and an offline subobject of the asset item, wherein said system readable identification enables the asset manager to create the information link between the online sub-object of the asset item and the off-line subject of the asset item.” As stated in column 3, lines 26 through 28, the Stark reference asset management System (AMS) is only “capable of collecting, tracking and disseminating real time information about Boiling Water Reactor internal components . . .”. Thus, there is no description of an offline database or creating an informational link between an online subobject of the asset item and an offline subobject of the asset item, as required by Independent Claim 1. Thus, the Final Office Action has failed to make a prima facie case of anticipation by the Stark reference of Independent Claim 1.

CONCLUSION

For the above reasons, it is respectfully requested that a review be made of the Final Office Action prior to filing of the Appeal Brief on the grounds that the rejections in the Final Office Action are deficient and that the Application in condition for allowance. Therefore, it is respectfully requested that the rejection of the claims be withdrawn and full allowance granted. Should the Examiner have any further comments or suggestions, please contact Jessica Smith at (972) 477-9109.

Respectfully submitted,
ALCATEL LUCENT

Dated: April 26, 2007

/Jessica W. Smith/

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PRE-APPEAL BRIEF REQUEST FOR REVIEW VIA EFS-WEB		Docket Number (Optional) 132489			
<p>I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]</p> <p>on <u>April 26, 2007</u></p> <p>Signature <u>/Melanie Murdock/</u></p> <p>Typed or printed name <u>Melanie Murdock</u></p>		Application Number 09/833,085	Filed 2001-04-11		
		First Named Inventor Yao Liang			
		Art Unit 3627	Examiner Andrew J. Rudy		
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p> <p>I am the</p> <table style="width: 100%; border: none;"><tr><td style="width: 50%; vertical-align: top; padding: 5px;"><p><input type="checkbox"/> applicant/inventor.</p><p><input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)</p><p><input checked="" type="checkbox"/> attorney or agent of record. 39,884 Registration number _____</p><p><input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____</p></td><td style="width: 50%; vertical-align: top; padding: 5px; border-top: 1px solid black;"><p style="text-align: center;">/Jessica W. Smith/</p><p style="text-align: center;">Signature</p><p style="text-align: center;">Jessica W. Smith</p><p style="text-align: center;">Typed or printed name</p><p style="text-align: center;">(972) 477-9109</p><p style="text-align: center;">Telephone number</p><p style="text-align: center;">April 26, 2007</p><p style="text-align: center;">Date</p></td></tr></table> <p>NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.</p>				<p><input type="checkbox"/> applicant/inventor.</p> <p><input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)</p> <p><input checked="" type="checkbox"/> attorney or agent of record. 39,884 Registration number _____</p> <p><input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____</p>	<p style="text-align: center;">/Jessica W. Smith/</p> <p style="text-align: center;">Signature</p> <p style="text-align: center;">Jessica W. Smith</p> <p style="text-align: center;">Typed or printed name</p> <p style="text-align: center;">(972) 477-9109</p> <p style="text-align: center;">Telephone number</p> <p style="text-align: center;">April 26, 2007</p> <p style="text-align: center;">Date</p>
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<p><input checked="" type="checkbox"/> *Total of <u>1</u> forms are submitted.</p>					

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**

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